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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,723	06/12/2001	Martin K. Tarvydas	INFS-1-16372	4943
66170 7590 01/19/2007 AMERICAN EXPRESS TRAVEL RELATED SERVICES CO., INC. c/o SNELL & WILMER, L.L.P. ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202			EXAMINER ROSEN, NICHOLAS D	
			ART UNIT 3625	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/19/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/880,723

Applicant(s)

TARVYDAS ET AL.

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,5,10-12,22-24,27,48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,10-12,22-24,27,48 and 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1, 2, 4, 5, 10, 11, 12, 22, 23, 24, 27, 48, and "49" (aka 52) have been considered.

#### ***Claim Objections***

Claims 1, 2, 4, 5, 10, 11, 12, 22, 23, 24, 27, 48, and 49 are objected to because of the following informalities: In the thirteenth line of claim 1, "said unaffiliated website" poses an antecedent basis problem, because the prior reference is to "one of said plurality of at least one of: affiliated and unaffiliated websites," with no requirement that that website be one of the unaffiliated websites, or even that there be any unaffiliated websites. Appropriate correction is required.

Claim 49 is objected to because of the following informalities: Claims 49-51 are listed as cancelled, so, to avoid contradiction, a new claim should be numbered 52 rather than 49. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim "49" is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification describes removing from the shopping cart a selected product when a price for the selected product reaches a predetermined level (especially page 15, lines 13-15), but does not disclose the different operation of adding to the shopping cart a selected product when a price for the selected product reaches a predetermined level.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 10, 12, 22, 23, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrove et al. (U.S. Patent 6,725,222) in view of Daly et al. (U.S.

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Patent 5,878,141). As per claim 1, Musgrove discloses a method of processing product orders, via a network, to allow consumers to order products from a plurality of merchants from a web page comprising a consistent user interface, comprising the steps of retrieving a universal shopping cart; searching a local database for information relating to a product prior to searching a plurality of at least one of: affiliated and unaffiliated websites for said information; displaying said information from said plurality of at least one of: affiliated and unaffiliated websites within said web page comprising a consistent user interface; receiving a product selection command from a consumer indicative of selecting a product; adding said selected product to the universal shopping cart; and injecting a product order at one of the plurality of at least one of: affiliated and unaffiliated websites associated with said selected product in said universal shopping cart (Abstract; column 2, lines 28-55; column 5, lines 14-48; column 7, lines 22-67; column 9, lines 1-16; and Figures 1-4), wherein the product order is injected to an unaffiliated website according to pattern matching (column 5, lines 30-48; column 6, line 47, through column 7, line 8; column 7, lines 22-67). Musgrove does not disclose identifying a common accepted payment method from the plurality of merchants, wherein said common accepted payment method is displayed within the webpage, but Daly teaches identifying and displaying a payment method accepted by a merchant, out of a plurality of merchants for which data is maintained, and matching acceptable forms of payment for multiple users (merchants and purchasers) (Abstract; column 3, line 60, through column 4, line 29; column 5, lines 47-60; column 7, lines 18-63; column 12, lines 35-42; Figures 2, 5, 6, and 7). Hence, it would have been obvious to one of

ordinary skill in the art of electronic commerce at the time of applicant's invention to identify a common accepted payment method from the plurality of merchants, and display said common accepted payment method within the webpage, for the stated advantage of enabling consumers to readily choose an acceptable payment method.

As per claim 10, Musgrove does not disclose the detailed procedure of obtaining services from a merchant's site associated with said product; pattern matching said services; and creating instances of parameterized service for each state that contain essential details required to navigate said merchant's site and place said product order, wherein a state is a set of methods and data that have input criteria and exit criteria for any section of the form in the check out process; but Musgrove does disclose obtaining service from a merchant's site associated with products, with pattern matching implied by search (column 5, lines 14-48), and the disclosed navigation of merchant sites and ordering of products (column 5, and the other sections cited in regard to claim 1 above) is held to imply instances of services with the essential details required to carry out Musgrove's disclosed method.

As per claim 12, this is held to be obvious on at least the grounds set forth with regard to claim 10 above.

As per claim 22, Musgrove discloses that the product information includes information on a plurality of products of the same product type sold by a plurality of merchants to allow the consumer to view product information on the web page comprising a consistent user interface in order to compare products of the same product type sold by different merchants (Abstract; column 5, lines 30-48).

As per claim 23, Musgrove discloses assigning a product key to each selected product to uniquely identify the selected product and a merchant associated with the selected product (*ibid.*, as per claim 1; Figures 3 and 4).

As per claim 48, Musgrove discloses that the local database can be populated by at least one product vendor (column 5, lines 14-29).

Claims 2 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrove and Daly as applied to claim 1 above, and further in view of Bezos et al. (U.S. Patent 6,029,141). As per claim 2, Musgrove does not expressly disclose that retrieving the universal shopping cart comprises determining whether an existing universal shopping cart is associated with the consumer, and creating a new universal shopping cart when no existing universal shopping cart is associated with the consumer, but Bezos teaches doing this (column 7, line 61, through column 8, line 31; column 14, lines 21-37). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do so, for the obvious advantage of arranging for the consumer to have a shopping cart as needed to make purchases, and for the stated advantages of enabling the consumer to conduct extended shopping sessions, and tracking and crediting referral events, and the obvious advantage of maintaining records of a particular consumer's orders, for future advertising, resolving disputes regarding products not received, or not in satisfactory condition, etc.

As per claim 24, Bezos teaches retrieving the shopping cart from a shopping cart database that includes consumer information and information on previously saved

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product items (column 7, line 61, through column 8, line 31; column 14, lines 21-37).

Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to do so, for the stated advantages of enabling the consumer to conduct extended shopping sessions, and tracking and crediting referral events, and the obvious advantage of maintaining records of a particular consumer's orders, for future advertising, resolving disputes regarding products not received, or not in satisfactory condition, etc.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrove and Daly as applied to claim 1 above, and further in view of Walker et al. (U.S. Patent 5,862,223). **As per claim 4**, Musgrove does not disclose retrieving reputation information on the consumer from a reputation database and sending said reputation information to the said merchant, but it is well known to maintain a database of reputation information on buyers and send the information to sellers, as taught, for example, by Walker (column 2, lines 11-14). **As per claim 5**, the reputation information in Walker is gathered by a form of polling merchants on their experiences with the consumer (ibid.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to retrieve such reputation information, send it to the merchant, and gather the reputation information by polling a subset of the plurality of merchants, as recited, for the stated advantage of enabling sellers to evaluate buyers' reputations (and thereby decide whether to do business with the buyers).



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Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrove and Daly as applied to claim 10 above, and further in view of official notice. Musgrove does not disclose that the services are obtained from the merchant's site by obtaining a copy of each page of the merchant's site relating to product orders using a plurality of accounts, but Musgrove discloses a plurality of shoppers with their distinct accounts (e.g., column 6, lines 32-46), and official notice is taken that it is well known to search all relevant pages of relevant websites, and/or to obtain copies, while Musgrove discloses culling product information from merchant sites by automated Web crawlers or other means (column 5, lines 14-48). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to obtain the services from each merchant's site by obtaining a copy of each page of said merchant's site relating to product orders using a plurality of accounts, for the obvious advantage of obtaining all relevant product information, so as to assist consumers in their searching and ordering of products.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrove and Daly as applied to claim 1 above, and further in view of official notice. Musgrove does not disclose that the consumer is an electronic agent of a human consumer, but such electronic agents (known as "shopping bots" or by similar terms) are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the consumer to be an electronic agent of a human consumer, for the obvious advantage of profiting from the business of human consumers using such electronic agents to find bargains.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrove and Daly as applied to claim 1 above, and further in view of the anonymous article, "CDW Computer Centers: CDW Computer Centers Takes Online shopping to the Next Level," hereinafter "CDW." Musgrove does not disclose at least one of: adding to and removing from the universal shopping cart said selected product when a price for the selected product reaches a predetermined level, but "CDW" teaches notifying customers when products on their shopping lists reach predetermined levels (paragraph beginning, "Unique to the industry"), and teaches allowing users to make buying decisions based on the best and most timely product information available (paragraph beginning, "Our mission is to make shopping"), suggesting that users would respond to notifications by adding or possibly removing selected products from product orders, making this obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention, for the stated advantage of allowing users to maximize their purchasing dollars, and make buying decisions based on the best and most timely product information available.

### ***Response to Arguments***

Applicant's arguments filed December 7, 2006 have been fully considered but they are not persuasive. Applicant argues that Musgrove is applicable only to affiliated, not unaffiliated, merchants; in support of this position, Applicant quotes Musgrove at column 7, lines 36-39, that "[b]uy procedures of merchant server 40 are integrated into buy processes of shopping server 20 to allow buy process 56 to automatically navigate

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merchant server 40.” Examiner notes, however, that the next sentence in Musgrove states, “Back end test scripts or the like can be used to determine the particular buy procedure of merchant server 40,” implying that the shopping server does not necessarily have any kind of affiliation agreement with the merchant server, but uses a test script to learn how to navigate the merchant server. Examiner concludes, based on this, and also column 5, lines 14-29, where Musgrove discloses culling product information from merchant servers by using bots, with no implied requirement of an affiliation relationship, that the merchant websites in Musgrove need not be affiliates.

Applicant argues that Daly (not “Daily”) discloses a computerized purchase mediation system that matches accepted merchant payment methods with a purchaser’s available payment methods, rather than automatically navigating a merchant website to facilitate a merchant transaction. Examiner replies that it was not contended that Daly discloses all aspects of the claimed method, but only that Daly teaches identifying and displaying a payment method accepted by a merchant, out of a plurality of merchants for which data is maintained, and matching acceptable forms of payment for multiple users.

It has been held that a prior art reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Daly is reasonably within the field of applicant’s endeavor, electronic commerce, involving a database of multiple merchants, and also reasonably

pertinent to the particular problem with which the applicant was concerned. Thus, Daly meets both prongs of a test, where meeting either prong would be sufficient.

Applicant's arguments regarding the alleged deficiencies of Bruno et al. (U.S. Patent 6,320,952) are moot, because, contrary to Applicant's statement, Examiner did not reject claims 2 and 24 as being unpatentable over Musgrove and Daly in view of Bruno, but as being unpatentable over Musgrove and Daly in view of Bezos et al. (U.S. Patent 6,029,141).

Applicant argues that Walker is not concerned with automatically navigating a merchant website to facilitate a purchase transaction, and instead discloses other features and purposes. Examiner replies that the details of the Walker system that were not relied upon in making the rejections are not relevant (much as with Daly). It is sufficient and more than sufficient that Walker is within the field of electronic commerce, and that Walker is reasonably pertinent to the particular problem with which the applicant was concerned, for an element of Walker to be applicable in judging what would have been obvious to one of ordinary skill in the art.

Regarding claims 11 and 27, Applicant concedes that the use of shopping bots, as such, is well known. Examiner points out that it is taught by Musgrove (e.g., column 5, lines 14-48, as cited in the rejection of claim 11). Official notice was taken only that it is well known to search all relevant pages of relevant websites, and/or to obtain copies (for claim 11), which Applicant does not claim as his original invention. Regarding claim 27, Musgrove does not disclose that the particular consumer of his system is an electronic agent of a human consumer, but such electronic agents are well known in

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general, and Applicant does not provide any reason why it would not have been obvious to put them to the particular use recited in claim 27.

The common knowledge or well-known in the art statements in the previous office action are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bonisteel ("Company Sees One Shopping 'Basket' for Entire Web 10/28/99") discloses an online shopping basket for submitting purchase orders to multiple merchants at once. The anonymous article, "BuyerZone.com Announces Most Advanced eCommerce System for Small to Mid-Sized Businesses," discloses a universal shopping cart that enables buyers to place online orders securely with multiple suppliers at once, and also alerting customers to a specific product reaching a particular price point.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith, can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Nicholas D. Rosen*  
**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

January 17, 2007